APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/924,208	08/07/2001	Jason F. Hunzinger	09752-097001/00-045/57771	1111

			EXAMINER
27572	7590	08/26/2004	NGUYEN, JOSEPH D

HARNESS, DICKEY & PIERCE, P.L.C.
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ART UNIT	PAPER NUMBER
2683	

DATE MAILED: 08/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No. 09/924,208	Applicant(s) HUNZINGER, JASON F.
Office Action Summary	Examiner Joseph D Nguyen	Art Unit 2683

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *07 August 2001*.
2a)☐ This action is **FINAL.**   2b)☒ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-83* is/are pending in the application.
    4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) *1-83* is/are rejected.
7)☐ Claim(s) _____ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.
10)☒ The drawing(s) filed on *07 August 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    a)☐ All b)☐ Some * c)☐ None of:
        1.☐ Certified copies of the priority documents have been received.
        2.☐ Certified copies of the priority documents have been received in Application No. _____.
        3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.
4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .
5)☐ Notice of Informal Patent Application (PTO-152)
6)☐ Other: _____.

DETAILED ACTION

Claim Objections

1.   Claim 8 is objected to because of the following informalities:

Regarding claim 8, this claim repeatedly claims "executing a program" twice, and in line

6, the abbreviation "URL" needs to be defined. Appropriate correction is required.

Claim Rejections - 35 USC § 102

2.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3.   Claims 1-7, 9-12, 14-24, 26-29, 31-43, 45-62, 64-73, 75-78, and 80-83 are

rejected under 35 U.S.C. 102(b) as being anticipated by Herz et al. (5,754,939).

Regarding claim 1, Herz et al. discloses a method of restricting distribution of an

action (col. 4 lines 36-51) and context description (col. 4 lines 51-67) pair to avoid

implicitly disclosing private context information due to fulfilling said action (abstract, fig.

2, col. 4 line 36 thru col. 8 line 7), comprising:

a) determining the number of context conditions that may satisfy said context

description (col. 5 lines 21-28, col. 12 lines 3-51, col. 43 line 8 thru col. 45 line 17); and

b) checking if the number of context conditions that may satisfy said context

description exceeds a limit (fig. 13B, col. 37 lines 40-60, and col. 43 lines 31-38).

Regarding claim 2, Herz et al. further discloses the method of claim 1, further comprising rejecting said action and context description pair if said limit is not exceeded and otherwise accepting said action and context description pair (col. 32 line 7-55).

Regarding claim 3, Herz et al. further discloses the method of claim 1, wherein said step of determining the number of context conditions that may satisfy a context description includes determining the number of users whose context may satisfy the context description in the future (col. 30 lines 15-27, and col. 36 lines 1-31).

Regarding claim 4, Herz et al. further discloses the method of claim 1, wherein said step of determining the number of context conditions that may satisfy a context description includes determining the number of locations (col. 30 lines 38-42) that may satisfy the context description in the future.

Regarding claim 5, Herz et al. further discloses the method of claim 1, further comprising sending a privacy alert to the user (fig. 13, col. 62 lines 13-44) if said: limit is not exceeded and said action may implicitly disclose private context information if executed (fig. 13, col. 62 lines 13-44).

Regarding claim 6, Herz et al. further discloses the method of claim 1, further comprising modifying said context description of said pair if said limit is not exceeded to expand (add) the number of context conditions which satisfy the context description (col. 17 lines 50-56, and col. 54 lines 4-58).

Regarding claim 7, Herz et al. further discloses the method of claim 1, further comprising generating additional context descriptions for said action so that said pair is associated with a larger number of context conditions and thereby masking an originally

requested action and context description pair (col. 61 line 56 thru col. 62 line 12, and

col. 72 lines 28-67).

Regarding claim 9, Herz et al. further discloses the method of claim 1, wherein

the action associated with said action and context description pair is performed with

user consent (user's agreement) (col. 5 lines 45-48).

Regarding claim 10, Herz et al. further discloses the method of claim 1, wherein

the action associated with said action and context description pair is performed without

user consent (denying the user service) (col. 33 lines 17-30).

Regarding claim 11, Herz et al. further discloses the method of claim 1, wherein

the action associated with said action and context description pair is performed with

user knowledge (col. 61 line 52 thru col. 62 line 55).

Regarding claim 12, Herz et al. further discloses the method of claim 1, wherein

the action associated with said action and context description pair is performed without

user knowledge (col. 61 lines 40-47).

Regarding claim 14, Herz et al. further discloses the method of claim 1, further

comprising monitoring by a mobile station (movable system) said mobile station's

current context with respect to the context description associated with said action and

context description pair and executing said action upon detecting that the current

context of said mobile station satisfies said context description (C1-C3, fig. 2, col. 30

line 29 thru col. 31 line 22).

Regarding claim 15, Herz et al. further discloses the method of claim 14, wherein

said monitoring occurs when an event selected from the group consisting of periodically,

upon detecting a current context change, and upon user initiated action, occurs (col. 19 line 33 thru col. 20 line 14).

Regarding claim 16, Herz et al. further discloses the method of claim 1, further comprising sending said action and context description pair to a plurality of mobile stations (abstract).

Regarding claim 17, Herz et al. further discloses the method of claim 1, wherein the context description associated with said action and context description pair is implemented in the form selected from the group consisting of a program (col. 26 lines 35-43), a script (col. 12 lines 46-50), and a parametric description (col. 6 lines 1-60).

Regarding claim 18, Herz et al. discloses a method of restricting distribution of an action (col. 4 lines 36-51) and context description (col. 4 lines 51-67) pair to avoid implicitly disclosing private context information due to fulfilling said action (abstract, fig. 2, col. 4 line 36 thru col. 8 line 7), comprising:

a) monitoring the generation of said action and context description pair (col. 55 line 43 thru col. 56 line 12);

b) computing the broadness of said context description (col. 12 line 52 thru col. 13 line 40);

c) searching for context conditions which satisfy said context description (col. 26 lines 20-42);

d) counting the number of context conditions that may satisfy said context description (col. 5 lines 21-28, col. 12 lines 3-51, col. 43 line 8 thru col. 45 line 17); and

e) checking if the number of context conditions that may satisfy said context

description exceeds a limit (col. 12 lines 3-51, col. 37 lines 40-60);

Regarding claim 19, this claim is rejected for the same reason as set forth in

claim 6.

Regarding claim 20, this claim is rejected for the same reason as set forth in

claim 2.

Regarding claim 21, this claim is rejected for the same reason as set forth in

claim 7.

Regarding claim 22, this claim is rejected for the same reason as set forth in

claim 3.

Regarding claim 23, this claim is rejected for the same reason as set forth in

claim 4.

Regarding claim 24, this claim is rejected for the same reason as set forth in

claim 5.

Regarding claim 26, this claim is rejected for the same reason as set forth in

claim 9.

Regarding claim 27, this claim is rejected for the same reason as set forth in

claim 10.

Regarding claim 28, this claim is rejected for the same reason as set forth in

claim 11.

Regarding claim 29, this claim is rejected for the same reason as set forth in

claim 12.

Regarding claim 31, this claim is rejected for the same reason as set forth in claim 14.

Regarding claim 32, this claim is rejected for the same reason as set forth in claim 15.

Regarding claim 33, this claim is rejected for the same reason as set forth in claim 16.

Regarding claim 34, this claim is rejected for the same reason as set forth in claim 17.

Regarding claim 35, Herz et al. further discloses the method of claim 18, wherein the action and context description pair is obtained from the wireless web (the user with movable system to obtain information from Web) (col. 12 lines 3-28, and col. 30 lines 29-40).

Regarding claim 36, Herz et al. further discloses the method of claim 18, wherein the action and context description pair is obtained from memory (col. 34 lines 32-33).

Regarding claim 37, Herz et al. discloses a mobile station (movable system) (col. 30 lines 29-40) for utilizing a plurality of action (col. 4 lines 36-51) and context (col. 4 lines 51-67) description pairs, in a wireless (remote) telecommunications network (fig. 2, col. 30 lines 29-63), comprising:

a) a memory which stores the plurality of action and context description pairs (col. 69 line 45 thru col. 70 line 17); and

b) a processor (col. 38 line 57 thru col. 40 line 57) which determines when the context description portion of one of the plurality of action and context descriptor pairs is satisfied and subsequently performs the corresponding action;

c) wherein the plurality of action and context description pairs are generated by generating means for determining the number of context conditions that may satisfy the context description (col. 5 lines 21-28, col. 12 lines 3-51, col. 43 line 8 thru col. 45 line 17), and for checking if the number of context conditions that may satisfy the context description exceeds a limit (col. 12 lines 3-51, col. 37 lines 40-60).

Regarding claim 38, this claim is rejected for the same reason as set forth in claim 2.

Regarding claim 39, this claim is rejected for the same reason as set forth in claim 3.

Regarding claim 40, this claim is rejected for the same reason as set forth in claim 4.

Regarding claim 41, this claim is rejected for the same reason as set forth in claim 5.

Regarding claim 42, this claim is rejected for the same reason as set forth in claim 6.

Regarding claim 43, this claim is rejected for the same reason as set forth in claim 7.

Regarding claim 45, this claim is rejected for the same reason as set forth in claim 9.

Regarding claim 46, this claim is rejected for the same reason as set forth in claim 11.

Regarding claim 47, this claim is rejected for the same reason as set forth in claim 13.

Regarding claim 48, this claim is rejected for the same reason as set forth in claim 14.

Regarding claim 49, this claim is rejected for the same reason as set forth in claim 15.

Regarding claim 50, this claim is rejected for the same reason as set forth in claim 16.

Regarding claim 51, this claim is rejected for the same reason as set forth in claim 17.

Regarding claim 52, Herz et al. discloses a server for processing of a plurality of action and context description pairs (abstract), in a wireless telecommunications network (abstract, fig. 2), comprising:

a) a memory (col. 34 lines 22-67) which stores the plurality of action and context description pairs; and

b) a processor for determining the number of context conditions that may satisfy the context description (col. 5 lines 21-28, col. 12 lines 3-51, col. 43 line 8 thru col. 45 line 17) and for checking if the number of context conditions that may satisfy the context description exceeds a limit (col. 5 lines 21-28, col. 12 lines 3-51, col. 43 line 8 thru col. 45 line 17).

Regarding claim 53, Herz et al. further discloses the server of claim 52, further comprising a monitor (fig. 14-15, col. 55 line 65 thru col. 56 line 49, col. 78 lines 37-67) which determines when the context description portion of one of the plurality of action and context descriptor pairs is satisfied and subsequently performs the corresponding action.

Regarding claim 54, Herz et al. further discloses the server of claim 52, further comprising a receiver to receive requests to deliver context-based content and instructions (col. 52 line 41 thru col. 53 line 39).

Regarding claim 55, Herz et al. further discloses the server of claim 52, further comprising a distributor to send said action and context description pairs to a plurality of mobile stations (movable systems) (C1-Cn fig. 2, col. 30 lines 29-40).

Regarding claim 56, this claim is rejected for the same reason as set forth in claim 2.

Regarding claim 57, this claim is rejected for the same reason as set forth in claim 3.

Regarding claim 58, this claim is rejected for the same reason as set forth in claim 4.

Regarding claim 59, this claim is rejected for the same reason as set forth in claim 5.

Regarding claim 60, this claim is rejected for the same reason as set forth in claim 6.

Regarding claim 61, this claim is rejected for the same reason as set forth in claim 7.

Regarding claim 62, this claim is rejected for the same reason as set forth in claim 8.

Regarding claim 64, this claim is rejected for the same reason as set forth in claim 15.

Regarding claim 65, this claim is rejected for the same reason as set forth in claim 17.

Regarding claim 66, Herz et al. discloses a system for distribution of an action and context description pair to control disclosure of private information due to executing said action (abstract, fig. 2), comprising:

a) a server to monitor the generation of said action and context description pair (abstract, S1 fig. 2, col. 55 line 43 thru col. 56 line 12); to search for context conditions that satisfy the context description (col. 26 lines 20-42), to count the number of context conditions pairs that may satisfy the context description and to check if the number of context conditions that may satisfy the context description exceeds a limit (col. 5 lines 21-28, col. 12 lines 3-51, col. 43 line 8-25); and

b) a mobile station (movable system) (C1 fig. 2, col. 30 lines 29-67) including means for receiving said action and context description pair.

Regarding claim 67, this claim is rejected for the same reason as set forth in claim 2.

Regarding claim 68, this claim is rejected for the same reason as set forth in claim 2.

Regarding claim 69, this claim is rejected for the same reason as set forth in claim 3.

Regarding claim 70, this claim is rejected for the same reason as set forth in claim 4.

Regarding claim 71, this claim is rejected for the same reason as set forth in claim 5.

Regarding claim 72, this claim is rejected for the same reason as set forth in claim 6.

Regarding claim 73, this claim is rejected for the same reason as set forth in claim 7.

Regarding claim 75, this claim is rejected for the same reason as set forth in claim 9.

Regarding claim 76, this claim is rejected for the same reason as set forth in claim 10.

Regarding claim 77, this claim is rejected for the same reason as set forth in claim 11.

Regarding claim 78, this claim is rejected for the same reason as set forth in claim 12.

Regarding claim 80, this claim is rejected for the same reason as set forth in claim 14.

Regarding claim 81, this claim is rejected for the same reason as set forth in claim 15.

Regarding claim 82, this claim is rejected for the same reason as set forth in claim 16.

Regarding claim 83, this claim is rejected for the same reason as set forth in claim 17.

Claim Rejections - 35 USC § 103

4.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5.   Claims 8, 25, 44, and 74 are rejected under 35 U.S.C. 103(a) as being unpatentable over Herz et al. (5,754,939).

Regarding claim 8, Herz et al. further discloses the method of claim 1, wherein the action associated with said action and context description pair is selected from the group consisting of delivering content to a user (col. 56 lines 29-49), making a call (col. 27 lines 58, and col. 28 lines 55-59), sending a short message (col. 31 lines 6-22), executing a program (col. 53 line 49 thru col. 53 line 7), executing a program (col. 53 line 49 thru col. 53 line 7), executing a script (col. 53 line 49 thru col. 53 line 7), starting a tracking activity (col. 58 lines 55-61), retrieving a web page (col. 12 lines 17-31), posting to a URL (col. 12 lines 3-38), downloading (transferring) a program (col. 32 lines

7-55, and col. 57 lines 8-12), downloading (transferring) parameters (col. 32 lines 7-55,

and col. 61 lines 23-55), and downloading (transferring) arguments for a program (col.

32 lines 7-55). However, Herz et al. does not specifically disclose downloading

arguments for a program. But it would have been obvious to one ordinary skilled in the

art at the time the invention was made to modify the Herz et al. system by replacing the

downloading (transferring) information between communication device and server with

downloading arguments for a program in order to provide the user with different choice

of services.

Regarding claim 25, this claim is rejected for the same reason as set forth in

claim 8.

Regarding claim 44, this claim is rejected for the same reason as set forth in

claim 8.

Regarding claim 74, this claim is rejected for the same reason as set forth in

claim 8.

6.   Claims 13, 30, 47, 63 and 79 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Herz et al. (5,754,939) in view of Nagendran (6,731,940).

Regarding claim 13, Herz et al. further discloses the method of claim 1, wherein

the context description associated with said action and context description pair includes

a description of a condition characteristic selected from the group consisting of a

location (30 lines 29-42), geographical area (col. 30 lines 1-2), time (col. 44 lines 20-25),

date (col. 44 lines 20-25), schedule (col. 76 lines 58-67), mobile state (col. 30 lines 29-

67), mobile status (col. 30 lines 29-67), processor load (col. 56 lines 30-35), memory availability (storage device) (col. 53 lines 9-39), proximity to a location (col. 8 line 48 thru col. 9 line 2), usage mode (col. 30 lines 15-18), usage history (col. 28 line 47 thru col. 28 line 41 and col. 41 lines 23-41), user profile (abstract), a status of another user terminal (col. 5 lines 6-67), a current context of another user terminal (col. 5 lines 6-67), . However, Herz et al. does not specifically disclose a condition characteristic selected from the group consisting of signal conditions, speed, direction of travel.

Nagendran teaches a condition characteristic selected from the group consisting of signal conditions (col. 4 line 55 thru col. 5 line 55), speed (abstract), direction of travel (col. 3 lines 4-13). Therefore, it would have been obvious to one ordinary skilled in the art at the time the invention was made to modify the Herz et al. system with the teaching of Nagendran of a condition characteristic selected from the group consisting of signal conditions, speed, direction of travel in order to provide the user with information dependent of location.

Regarding claim 30, this claim is rejected for the same reason as set forth in claim 13.

Regarding claim 47, this claim is rejected for the same reason as set forth in claim 13.

Regarding claim 63, this claim is rejected for the same reason as set forth in claim 13.

Regarding claim 79, this claim is rejected for the same reason as set forth in claim 13.

7.   Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

Or faxed to:

703 308-9051, (for formal communication intended for entry)

Or:

(703) 305-9509 (for informal or draft communications, please label

"PROPOSED" OR "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121

Crystal Drive, Arlington. VA. Sixth floor (Receptionist).

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Joseph D Nguyen whose telephone number is (703)

605-1301. The examiner can normally be reached on 7:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, William Trost can be reached on (703) 308-5318. The fax phone numbers

for the organization where this application or proceeding is assigned are (703) 872-9314

for regular communications and (703) 872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or

proceeding should be directed to the receptionist whose telephone number is (703) 306-

0377.

Joseph Nguyen

WILLIAM TROST
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600

Aug. 17, 2004